

REMARKS

In response to the Office Action dated November 2, 2005, the Applicants have amended independent claims 1, 6, 13, 15, 23, 28, 36, 40 and 46. Claims 1-48 remain in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected the specification under 37 CFR 1.75(d)(1) and MPEP 608.01(o) as failing to provide proper antecedent basis for the claimed subject matter. In addition, the Office Action rejected claims 1-48 under 35 U.S.C. 112, first paragraph.

The Applicants respectfully traverse these rejections and submit that the claims comply with 37 CFR 1.75(d)(1), MPEP 608.01(o), and 35 U.S.C. 112, first paragraph. However, in an effort to expedite the prosecution of this case, the Applicants have amended the independent claims to replace "to be approved by a publisher for preserving temporal dimensions of a work of authorship" with --, wherein the delivery schedule is required to comply with publisher defined physical and temporal dimensions of the content to preserve artistic qualities of the content--. Support can be found in FIG. 1 and on pages 3-5.

For example, the first full paragraph of the Detailed Description of the Preferred Embodiment of the specification states "[T]he publisher can require that the sequential information (content) be delivered only in ascending sequential order, for example. Or, the sequential information can only be delivered as a portion, a single issue, in the sequence and only be delivered in a particular time frame. For **artistic** reasons, an author may require that one chapter of a novel must be followed by a period of time during which the next chapter will not be allowed to be delivered. The present invention offers a new physical and temporal dimension to works of authorship while still enabling a consumer to receive the content in portions on a convenient schedule." [*emphasis added*].

The Office Action rejected claims 1-8, 10-20, 23-34, 36-42, and 44-48 under 35 U.S.C. 103(a) as allegedly being unpatentable over Stumm (U.S. Patent No. 5,768,528) in view of Peterson et al. (U.S. Patent No. 6,594,682). Also, the Office Action rejected claims 9, 21-22, 35, and 43 under 35 U.S.C. 103(a) as allegedly being unpatentable over Stumm in view of Peterson et al. and further in view of Milovanovic et al. (U.S. Patent No. 6,484,198).

The Applicants traverse these rejections because the combined cited references are missing elements of the amended claimed invention. Namely, with regard to claims 1-8, 10-20, 23-34, 36-42, and 44-48, Stumm combined with Peterson et al. merely disclose providing information files to a plurality of subscribers over the Internet, wherein a database server maintains a schedule of events file adapted to contain information relating to predetermined downloading schedules to the subscribers of the database server and a client-based system

with a scheduling subsystem to schedule a time to obtain the Web content from the server. (see Abstracts of Stumm and Petersen et al.). With regard to claims 9, 21-22, 35, and 43, Stumm combined with Peterson et al. and Milovanovic et al. simply disclose the above with a file locator (see col. 2, lines 10-25 of Milovanovic et al.).

Although Petersen et al. disclose that "...descriptive information can be used to categorize the Web content...", (see col. 6, lines 17-26 of Petersen et al.), the combined references are still missing the Applicants' claimed delivery schedule that is required to comply with publisher defined physical and temporal dimensions of the content to preserve artistic qualities of the content. In addition, these elements have advantages not appreciated by the combined cited references. For instance, as discussed on page 3, lines 14-26, of the Applicants' specification, "[B]y allowing a consumer to subscribe to a multi-issue publication and set their own schedule for distribution, a service enables the consumer to read the publication at their leisure and allows the electronic publisher to not be required to monitor the content for time sensitive material.

Moreover, the publisher often wishes to maintain control over certain parameters of the publication for artistic, economic, timing, and other reasons. The publisher can require that the sequential information (content) be delivered only in ascending sequential order, for example. Or, the sequential information can only be delivered as a portion, a single issue, in the sequence and only be delivered in a particular time frame. For artistic reasons, an author may require that one chapter of a novel must be followed by a period of time during which the next chapter will not be allowed to be delivered. **The present invention offers a new physical and temporal dimension to works of authorship while still enabling a consumer to receive the content in portions on a convenient schedule.** *[emphasis added]*.

Further, even though the combined references do not disclose, teach, or suggest the Applicants' claimed invention, the references should not be considered together because Stumm teach away from the Applicants' invention. For example, Stumm disclose that "...each publisher is allowed to control the times which a subscriber is scheduled to access server system 20." This is the opposite of the Applicants' claimed invention, which allows the subscriber, and not the publisher, to control delivery times and schedules. Instead, Stumm explicitly state that "[T]hus, each publisher is allowed to control the times which a subscriber is scheduled to access server system 20." (see col. 9, lines 20-27 and lines 45-51), which is a teaching away from the Applicants' claimed invention.

Thus, allowing a subscriber to create and control custom delivery schedules would

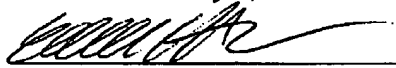
contradict the statement made in col. 9, lines 20-27 and lines 45-51 of Stumm. Consequently, this element of the Applicants' claimed invention would destroy the main function, purpose and spirit of Stumm. As such, this "teaching away" prevents this reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Therefore, since the claimed elements of a delivery rule received from the user or subscriber for the content and enabling the subscriber to create and control a custom issue delivery schedule are not disclosed by Stumm and because Stumm, teaches away from the Applicants' invention, Stumm cannot render the claims obvious, and hence, the Applicants submit that the rejection should be withdrawn. *MPEP 2143*.

With regard to the rejection of the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (*MPEP* § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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